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Bell, Boyd & Lloyd LLC  
P.O. Box 1135  
Chicago, IL 60690-1135

EXAMINER

ASHBURN, STEVEN L

ART UNIT PAPER NUMBER

3714

DATE MAILED: 06/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/715,638

**Applicant(s)**

KAMINKOW, JOSEPH E.

**Examiner**

Steven Ashburn

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/18/03</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Objections*

Claims 46-54 objected to because the claims are misnumbered. Claim 46 appears twice. For the purposes of examination, the repeated claims are referred to as "46(a)" and "46(b)". Correction is required.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claims 1-38 and 49-54 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-62 of U.S. Patent No. 6,695,696 B1.**

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the '696 patent describe a gaming device comprising: a cabinet; means supported by the cabinet for displaying a plurality of symbols and a plurality of paylines; a replicating device

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supported by the cabinet and operable to independently display said symbols and the plurality of paylines; a controller operable with the display means and the replicating device to cause the replicating device to independently mirror the symbols and movement of the symbols displayed by the display means, and upon said displayed symbols on at least two paylines yielding an award to a player, to cause the replicating device to sequentially and separately display each of the award yielding paylines and symbols thereon wherein the display means includes at least one mechanical reel and the replicating device is adapted to display a simulation of the mechanical reels. Consequently, it would have been obvious to an artisan at the time of the invention to modify the '696 claims to provide a gaming device operated under the control of at least one processor, said gaming device comprising: a cabinet; a plurality of reels controlled by the processor, said reels mounted to the cabinet; a plurality of symbols on each of said reels; and a video display controlled by the processor and mounted to the cabinet, wherein when the reels are activated and spin, the video display displays at least one image of each of the reels spinning and then images of the symbols which are generated and displayed on each of the reels after the reels stop spinning.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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**Claims 1-7, 9-16, 18-25, 29-36 and 49-54 are rejected under 35 U.S.C. 102(b) as being anticipated by Thomas, GB 558307-A2, (Jan. 9, 1993).**

Thomas discloses gaming machine has a set of electro-mechanical reels and a set of simulated reels on a video screen. *See abstract*. The particular features of the listed claims taught by Thomas are discussed below.

Claims 1, 10, 18, 19, 29, 49 and 52. A gaming device operated under the control of at least one processor, said gaming device comprising: a cabinet; a plurality of reels controlled by the processor, said reels mounted to the cabinet; a plurality of symbols on each of said reels; and a video display controlled by the processor and mounted to the cabinet, wherein when the reels are activated and spin, the video display displays at least one image of each of the reels spinning and then images of the symbols which are generated and displayed on each of the reels after the reels stop spinning. *See fig.1; col. 1:46-2:38, 3:55-4:35, 4:51-5:15*.

Claims 2, 11, 30, 50 and 53. Reels include at least one mechanical reel. *See id*.

Claims 3 and 12. Reels include a plurality of mechanical reels. *See id*.

Claims 4, 13, 32, 51 and 54. Reels include at least one simulated reel. *See id*.

Claims 5 and 14. Reels include a plurality of simulated reels. *See id*.

Claims 6, 15, 22, 23, 34 and 35. Payline associated with the reels, wherein the video display is adapted to display said payline associated with said reels. *See id*.

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Claims 7, 16, 24 and 36. Video display device is adapted to display a pay chart of each award value resulting from any winning combination of symbols on each payline. *See col. 5:8-11.*

Claims 9, 20 and 33. Display a plurality of images of the reels spinning at a slower rate than a rate of said reels spinning. *See col. 4:56-5:5:1.*

Claims 21 and 31. Displaying an oscillation of at least one of the said reels. *See fig.1; col. 1:46-2:38, 3:55-4:35, 4:51-5:15.*

Claim 25. Simultaneously displaying said award values in said pay chart. *See col. 5:8-11.* It is implicit that the pay chart displays award values because the purpose of the pay chart is to associate award values with symbol combinations.

**Claims 39-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Frohm et al., U.S. 6,159,095 (Dec. 12, 2000).**

Frohm discloses an electronic video gaming machine for playing multiple games simultaneously. *See abstract..* The particular features of the listed claims taught by Frohm are discussed below.

Claim 39. A gaming device comprising: a cabinet; a display device mounted to said cabinet; a plurality of symbol generating devices displayed to a first area of said display device, each of said symbol generating devices adapted to generate at least one symbol; a plurality of separate paylines associated with the symbol generating devices; and a separate pay chart adapted to be displayed in a second different area of said display device, wherein for each of the plurality of paylines, said pay chart is adapted to display an identification of the payline and an indication of any award value resulting from the symbols

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generated by the symbol generating devices after said generation of symbols and indicated on said payline. *See fig. 1, 7; col. 5:36-6:28, 9:14-57.*

Claim 40. Simultaneously indicate the award values resulting from the symbols indicated on the paylines. *See id.*

Claim 41. Separately and sequentially indicate the award values resulting from the symbols indicated on the paylines. *See id.*

Claim 42. The gaming device of claim 39, wherein said pay chart is adapted to display a total value of the award values resulting from the symbols indicated on the paylines. *See id.*

Claim 43. Symbol generating device are reels. *See id.*

Claim 44. A method of operating a gaming device, said method comprising: (a) displaying a plurality of symbol generating devices in a first area of a display device, each of said symbol generating devices adapted to generate at least one symbol; (b) displaying a plurality of paylines associated with the symbol generating devices; and (c) displaying a pay chart in a second different area of said display device, wherein for each of the plurality of paylines, said pay chart displays an identification of the payline and an indication of any award value resulting from the symbols generated by the symbol generating devices after said generation of symbols and indicated on said payline. *See fig. 1, 7; col. 5:36-6:28, 9:14-57.*

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Claim 45. Simultaneously displaying the award values resulting from the symbols generated by the symbol generating devices indicated on said paylines in said pay chart. *See id.*

Claim 46(a). Separately and sequentially displaying the award values resulting from the symbols generated by the symbol generating devices indicated on said paylines in said pay chart. *See id.*

Claim 46(b). Displaying a total value of the award values displayed in the pay chart.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 8, 17, 27, 28, 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas.**

Claims 8 and 17. Thomas does not disclose images of the symbols displayed by said video display being larger than said symbols on said reels. Regardless, changing the size of the symbols is a merely an aesthetic change to the display which does not alter the function of the system. Thus, the feature does not patentably distinguish to claimed invention over Thomas. Moreover, it is notoriously well known to make images larger to make them easier for people to read. Thus, by official notice, it would have been obvious to an artisan at the time of the invention to modify Thomas to add the feature displaying the symbols on the video display larger than said symbols on said reels in order to make them easier for players to read.



Claims 27, 28, 37 and 38. Thomas does not disclose controlling the steps of the of the game program through a data network including the internet. Regardless, it is notoriously well known to control game over networks to allow players to participate in games from remote locations rather than traveling to a casino and thereby increase the number of potential customers for the gaming services. Thus, by official notice, it would have been obvious to an artisan at the time of the invention to modify the gaming device disclosed by Thomas to add the feature of controlling the steps of the of the game program through a data network including the internet to allow remotely located players to participate in games and thereby increase operator revenue due to the increased customer base.

**Claims 47 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frohm.**

Frohm does not disclose controlling the steps of the of the game program through a data network including the internet. Regardless, it is notoriously well known to control game over networks to allow players to participate in games from remote locations rather than traveling to a casino and thereby increase the number of potential customers for the gaming services.. Thus, by official notice, it would have been obvious to an artisan at the time of the invention to modify the gaming device disclosed by Frohm to add the feature of controlling the steps of the of the game program through a data network including the internet to allow remotely located players to participate in games and thereby increase operator revenue due to the increased customer base.

**Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas in view of Frohm.**

Thomas does not disclose separately and sequentially displaying said award values in a pay chart. Frohm discloses revealing game results separately and sequentially. *See col. 5:49-65*. In view of Frohm, it would have been obvious to an artisan at the time of the invention to modify Thomas to add the feature of separately and sequentially displaying said award values in a pay chart. As suggested by Frohm, the modification would enhance the game by revealing information to achieve different visual effects which enhance the player's feeling of excitement. *See id.*

***Prior Art, Not Relied On***

The following prior art of record is not relied upon but is considered pertinent to applicant's disclosure:

- a. WO 98/00207 discloses a gaming machine using video displays to present typical gaming data inn a "dynamically and graphically". *See, e.g., p. 2, lines 22-24*.
- b. U.S. 5,375,830 discloses a slot machine having means for highlighting winning outcomes.
- c. U.S. 5,088,737 discloses a gaming machine that duplicates winning outcomes on a video display.
- d. U.S. 4,976,016 discloses a gaming machine that identifies winning paylines on a video display .

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Ashburn whose telephone number is 703 305 3543. The examiner can normally be reached on Monday thru Friday, 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are

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unsuccessful, Primary Examiner Jessica Harrison can be reached on 703-308-2217. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

s.a.

A handwritten signature in black ink, consisting of a stylized 'J' and 'H' followed by a horizontal line.

**JESSICA HARRISON  
PRIMARY EXAMINER**